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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,372	07/11/2003	Mark G. Gilreath	P-4438-US	2855
49443 7590 11/29/2009 Pearl Cohen Zedek Latzer, LLP 1500 Broadway 12th Floor New York, NY 10036				
EXAMINER				
KISH, JAMES M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/617,372

Applicant(s)

GILREATH ET AL.

Examiner

JAMES KISH

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 7, 10, 11 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 7, 10, 11 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/19/09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed July 1, 2009 have been fully considered but they are not persuasive.

On page 5, the Applicant argues that Hidaka and Kislev, "alone or in combination, do not teach or suggest an internal power source in the non-inserted end or a wireless transmitter in the in-vivo inserted end." The Examiner agrees that a wireless transmitter is not taught by these references. Those claim limitations were previously rejected further in view of Ueda. Regarding the power source, this claim limitation is new and the closest limitation from which it may have spawned is previous claim 23 from the claim set dated February 24, 2009 in which "said central body comprises a battery."

Then on page 6, the Applicant argues that Hidaka in view of Kislev and Ueda fails to cure these previous deficiencies, as well as failing to teach "a control unit on the non-inserted end for controlling the inserted end of the endoscope. Ueda et al. instead teach a separate magnetic device used to control the movement of the inserted end of the endoscope." The Examiner disagrees that the claim language, as written, is not taught by Ueda.

Figures 1 and 79(a) of Ueda clearly illustrate the system. The endoscope has an inserted portion (which is inserted into the patient) and a non-inserted end. The non-inserted end includes controlling apparatus 12 and camera controlling unit (CCU) 6. Controlling apparatus 12 is further connected to a magnetic unit which controls a

magnetic field which actively controls the inserted end of the endoscope. However, this magnetic unit would not function without the controlling apparatus **12**. Therefore, Ueda positively teaches a control unit for controlling the movement of said in-vivo inserted end. Regarding a power source, Figure 3(A) illustrates the magnetic field generating unit which actively controls the inserted end. Numeral **33** is a power source. As previously described, this unit is in connection to the non-inserted end and makes up a portion of the non-inserted end of the Ueda device. Furthermore, it would be obvious to one of skill in the art that the system (which comprises monitor **7**, and controlling units **12** and **6**) would comprise a power source. This is further exemplified in Figure 29. Unit **231** "is provided with two direct current power sources 232 and 233 and a switching switch 234 (column 19, lines 61-65)." Therefore, Ueda teaches and/or suggests that a power source is located in the non-inserted end portion of the endoscope.

Regarding the failure to teach a wireless transmitter for wirelessly transmitting said in-vivo image information to an external receiver, the Examiner first notes that, as written, "for wirelessly transmitting said in-vivo image information to an external receiver" is intended use language. Section 2113 of the MPEP states, "A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987." Section 2114 of the MPEP states (with emphasis in the original), "Apparatus claims cover what a device is,

not what a device *does*.' *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)."

In view of the previously cited portions of the MPEP and the interpretation of this claim language as previously stated, Ueda teaches a wireless transmitter within the inserted end of the endoscope, as stated in the previous Office Action.

Secondly, Ueda teaches "a transmitting and receiving part 157 transmitting and receiving the output signal of said CCD 153 (column 18, lines 19-22)." This is described with regard to a capsule-type embodiment of the endoscope. However, Ueda further states, "Said control apparatus 160 comprises a transmitting and receiving part 161 transmitting and receiving signals with or without wires between it and the transmitting and receiving part 157 of said capsule type endoscope 150 (column 18, lines 28-30)." Therefore, the disclosure of Ueda teaches a wireless transmitter (or in the alternative, a wired transmission) from the CCD image pick-up device and a receiver. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to use a wired connection, or alternatively, a wireless connection between the CCD and the receiver unit as taught by Ueda in the situation in which the endoscope was a traditional, catheter-type endoscope or if it were a capsule-type endoscope.

For at least the reasons above, the rejection of the claims based on Hidaka, Kislev and Ueda still stands. Changes to the previous rejection have been made solely based on the amendments to claim 1 and therefore, claim 1 is now being rejected in view of all three of these references.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3, 4, 7, 10, 11 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidaka et al. (US Patent No. 6,095,970) – herein referred to as Hidaka – in view of Kislev et al. (WO 00/76391) – herein referred to as Kislev – and further in view of Ueda et al. (US Patent No. 5,681,260) – herein referred to as Ueda.

Hidaka discloses an endoscope including an insertion tube which is inserted into a human body (*see* Abstract). The second embodiment of Hidaka -- found at column 6, line 1 through column 7, line 49 and illustrated in Figures 5 and 6 -- describes a unit body accommodating an object optical system (i.e., lenses) and a CCD (i.e., an imager).

The object optical system is covered by a view window 211 (which is dome-shaped) disposed at the front end of the unit body. This embodiment also has a first and second channel **238** and **239** that line up to allow a medical instrument to pass through to the exit opening into the patient. An exemplary medical instrument is forceps. However, this second embodiment fails to teach an illumination source. Several of the other embodiments of Hidaka teach an illumination source being fed through the channel which in the second embodiment is used for the medical instrument. However, this would not allow a medical instrument to be used in a procedure while illumination is provided, thereby defeating the second embodiment all together. Kislev teaches an optical system for illuminating and viewing a target in which an illumination element and a receiving element are disposed behind a single optical window (see Abstract). Page 1, lines 18-19 of Kislev teaches, "examples of such optical systems can be found in diagnostic apparatuses such as endoscope devices." It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an illuminating element behind the same optical window as the imager, as taught by Kislev, in the endoscope of Hidaka, because these optical systems (i.e., a single optical window) have advantageous (page 2, line 1 of Kislev). In diagnostic apparatuses, especially those meant to be inserted into body orifices, having a single optical window is advisable for hygienic and practical considerations (page 2, lines 8-10 of Kislev). Furthermore, it would allow a medical instrument, such as forceps, to be used in the second embodiment of Hidaka while illumination and imaging is taking place, thereby allowing the surgeon to view the area which is being operated on by the forceps.

However, neither of these two references explicitly state that an LED is used or teach wirelessly transmitting data. Ueda discloses a guiding apparatus for guiding an insertable body within an inspected object. Ueda, similarly to Hidaka, teaches an endoscope with a functional unit. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a wireless transmission unit, as taught by Ueda, in the device of Hidaka as a functional equivalent to providing a hardwire link. Ueda explicitly states, "Said control apparatus comprises a transmitting and receiving part transmitting and receiving signals with or without wires (column 18, lines 27-38; emphasis added).

Regarding claim 3, Hidaka teaches that the tool is made of plastic such as tetrafluoroethylene or Derlin (column 7, lines 42-43).

Regarding claim 4, Hidaka's example of a medical instrument is forceps (column 7, line 3).

Regarding claim 7, one embodiment Ueda teaches an LED is utilized as the illumination device (see column 18, lines 9-27 and Figure 27).

Regarding claims 10, Ueda teaches that information and instruction can be sent wirelessly between the device and the controlling apparatus (column 18, lines 27-38).

Regarding claim 11, Hidaka teaches a first and second channel **238** and **239** that line up to allow a medical instrument to pass through to the exit opening into the patient.

Regarding claims 18-20, Ueda teaches that information can be passed to and from the device via a transmitter and a receiver (column 18, lines 18-20). Within the

process circuit, there is a memory unit, as described in column 24, lines 35-47. The system illustrated in Figure 1(a) comprises monitor 7.

Also, see the *Response to Arguments* section, herein incorporated by reference, for further description of an internal power source and a control unit in the non-inserted end and for a wireless transmitter in the in-vivo inserted end, as being taught by Ueda.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES KISH whose telephone number is (571)272-5554. The examiner can normally be reached on 8:30 - 5:00 ~ Mon. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRIAN CASLER/
Supervisory Patent Examiner, Art
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JMK